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Applicants:	Georgia L. Zehner et al.	Docket No.:	18,495
Serial No.:	10/680,967	T.C./A.U.:	1771
Confirmation No.:	6069	Examiner:	Elizabeth M. Cole
Filed:	October 7, 2003	Date:	November 26, 2008
For:	COMPOSITE OUTER COVERS ADAPTED TO ATTAIN 3-D CONFIGURATIONS		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Corrected Brief on Appeal (30 pages)

31 total pages, including this page

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For: COMPOSITE OUTER COVERS ADAPTED TO ATTAIN 3-D CONFIGURATIONS

Corrected Brief on Appeal to the Board of Patent Appeals and Interferences

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. 41.37 Appellants respectfully submit this Brief in support of their Appeal of Examiner Cole's **Final Rejection** of claims 1-23, which was mailed on November 27, 2006.

On February 1, 2007, Appellants, pursuant to 37 C.F.R. 41.31, mailed a timely Notice of Appeal. A Brief on Appeal was mailed on February 19, 2007. A Notification of Non-Compliant Appeal Brief was mailed on April 19, 2007 followed by a Corrected Brief on Appeal mailed on May 16, 2007. The Examiner's Answer was mailed on September 4, 2007. A Reply Brief was mailed on November 5, 2007 in response to the Examiner's Answer. The enclosed Brief amends and replaces the original Brief dated February 19, 2007 and the Corrected Brief mailed on May 16, 2007and is being filed in response to the Notification of Non-Compliant Appeal Brief mailed on October 28, 2008. Thus, this Brief is timely.

Real Party in Interest

Kimberly-Clark Worldwide, Inc., the assignee of the present patent application, is the real party in interest. Kimberly-Clark Worldwide, Inc. is a wholly-owned subsidiary of Kimberly-Clark Corporation.

Related Appeals and Interferences

A decision on appeal was rendered in related case U.S. Patent Application Serial No. 10/680,968 on August 21, 2007. A copy of the decision is attached hereto in the Related Proceedings Appendix of this Brief.

Status of Claims

Claims 1-23 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants' regard as the invention.

Claims 2-13 and 17-23 stand rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential elements.

Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as being obvious and therefore unpatentable over European Patent Application EP 650,714 A1 to Coles (hereinafter "Coles") alone or in view of U.S. Patent No. 6,287,288 to Osborn III et al. (hereinafter "Osborn").

Accordingly, claims 1-27 are under appeal. A copy of the pending claims appears in the Claims Appendix of this Brief.

Status of Amendments

No amendments were filed after the final Office Action mailed November 27, 2006.

Summary of Claimed Subject Matter

The following summary correlates claim elements to specific embodiments described in the application specification, but does not in any manner limit claim interpretation. Rather, the following summary is provided only to facilitate the Board's understanding of the subject matter of this appeal.

Independent claim 1 is directed to a disposable absorbent article, as representatively illustrated, for example, in Figs. 15 and 16. The absorbent article has a longitudinal centerline (70) and a lateral centerline (72). Page 12, lines 12-13. The article includes a fluid permeable liner (48). Page 10, lines 7-36. The article also includes a composite outer cover (30) including an extensible, liquid impermeable outer cover material (32) having an upper surface (36) and an opposing lower surface (38). Page 3, line 34 to page 9, line 4. The composite outer cover (30) also includes a non-tensioned elastic (34). Page 3, line 34 to page 4, line 8 and page 6, line 7 to page 9, line 4. The non-tensioned elastic (34) is associated with at least a portion of a surface (36, 38) of the outer cover material (32). Page 3, line 4 to page 4, line 8 and page 6, lines 7-29. Upon activation of the composite outer cover (30), at least a portion of the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are associated is adapted to (i) have a retraction capability differential of at least 10% (see page 8, lines 7-31) and (ii) attain a three-dimensional configuration (see page 7, line 23 to page 8, line 6). At least that portion of the outer cover material (32) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are associated is adapted to extend no less than 25%. Page 4, lines 9-37. The article also includes an absorbent core (50) disposed intermediate the liner (48) and the composite outer cover (30). Page 11, lines 1-35.

Independent claim 14 is directed to a composite cover (30) suitable for incorporation into a disposable absorbent article, as representatively illustrated, for example, in Figs. 15 and 16. The outer cover composite (30) includes an extensible, liquid impermeable outer cover material (32) having an upper surface (36) and an opposing lower surface (38). Page 3, line 34 to page 9, line 4. The outer cover composite (30) also includes a non-tensioned elastic (34). Page 3, line 34 to page 4, line 8 and page 6, line 7 to page 9, line 4. The non-tensioned elastic (34) is associated with at least a portion of a surface (36, 38) of the outer cover material (32). Page 3, line 4 to page 4, line 8 and page 6, lines 7-29. Upon activation of the composite outer cover (30) at least that portion of the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are associated is adapted to: (i) have a retraction capability differential of at least 10% (see page 8, lines 7-31) and (ii) attain a three-dimensional configuration (see page 7, line 23 to page 8, line 6).

Independent claim 24 is directed to a disposable absorbent article, as representatively illustrated, for example, in Figs. 15 and 16. The absorbent article has a longitudinal centerline (70) and a lateral centerline (72). Page 12, lines 12-13. The article includes a fluid permeable liner (48). Page 10, lines 7-36. The article also includes a composite outer cover (30) joined to the fluid permeable liner (48), the composite outer cover (30) including an extensible, liquid impermeable outer cover material (32) having an upper surface (36) and an opposing lower surface (38). Page 3, line 34 to page 9, line 4. The composite outer cover (30) also includes a non-tensioned elastic (34). Page 3, line 34 to page 4, line 8 and page 6, line 7 to page 9, line 4. The non-tensioned elastic (34) is joined to the outer cover material (32). Page 3, line 4 to page 4, line 8 and page 6, lines 7-29. At least a portion of the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are joined, when extended no less than 25% with a tensile force of 30 gmf per inch, has a retraction capability differential of at least 10% and attains a three-dimensional configuration. Page 4, lines 9-37 and page 7, line 23 to page 8, line 6. The article also includes an absorbent core (50) disposed intermediate the liner (48) and the composite outer cover (30). Page 11, lines 1-35.

Independent claim 26 is directed to a disposable absorbent article, as representatively illustrated, for example, in Figs. 15 and 16. The article has a longitudinal centerline (70) and a lateral centerline (72). Page 12, lines 12-13. The article includes a fluid permeable liner (48). Page 10, lines 7-36. The article also includes a composite outer cover (30) joined to the fluid permeable liner (48), the composite outer cover (30) including an extensible, liquid impermeable outer cover material (32) having an upper surface (36) and an opposing lower surface (38). Page 3, line 34 to page 9, line 4. The composite outer cover (30) also includes a non-tensioned elastic (34). Page 3, line 34 to page 4, line 8 and page 6, line 7 to page 9, line 4. The non-tensioned elastic (34) is joined with at least a portion of a surface (36, 38) of the outer cover material (32). Page 3, line 4 to page 4, line 8 and page 6, lines 7-29. Upon elongation and retraction of the composite outer cover (30) during normal use of the disposable absorbent article, at least a portion of the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are joined is adapted to have a retraction capability differential of at least 10% (see page 8, lines 7-31), and attain a three-dimensional configuration (see page 7, line 23 to page 8, line 6). At least that portion of the outer cover material (32) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are joined is adapted to extend no less than 25% at a tensile force of 30 gmf per inch. Page 4, lines 9-37. The article also includes an absorbent core (50) disposed intermediate the liner (48) and the composite outer cover (30). Page 11, lines 1-35.

Grounds of Rejection to be Reviewed on Appeal

Ground 1

Claims 1-23 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Under Ground 1, claims 1-23 are argued as a group.

Ground 2

Claims 1-27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. Under Ground 2, claims 1-27 are argued as a group.

Ground 3

Claims 2-13 and 17-23 stand rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential elements. Under Ground 3, claims 2-13 and 17-23 are argued as a group.

Ground 4

Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as being obvious and therefore unpatentable over European Patent Application EP 650,714 A1 to Coles (hereinafter "Coles") alone or in view of U.S. Patent No. 6,287,288 to Osborn III et al. (hereinafter "Osborn"). Under Ground 4, claims 1-27 are argued as a group.

Argument

Ground 1 – Rejection Of Claims 1-23

Claims 1-23 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Appellants respectfully submit that the Examiner's rejection is improper and should be reversed.

What is meant by activation and how activation is achieved is discussed throughout the application, and attention is directed to page 7, line 31 to page 8, line 6 and particularly page 7, line 37 to page 8, line 3 where it states, "this phenomenon upon activation (i.e., when the absorbent article is being donned on the wearer or during use by the wearer) creates a three-dimensional ("3-D") effect on at least one of the surfaces (36, 38) of the outer cover material (32) of the composite outer cover (30)." That is, the act of putting on (i.e., donning), or during use of the article, activates the inventive composite material by a combination of stretching and retracting portions of the composite material. Attention is also directed to page 8, lines 7-31, which further discusses the "retraction capability differential" and the impact that this has upon the inventive composite material. Also, see page 12, line 6 to page 13, line 28 and particularly page 12, line 26 to page 13, line 28, as well as the figures discussed in these portions of the specification. Based on at least these portions of the claims and the specification, it is respectfully submitted that one of ordinary skill in the art would readily understand how to enable the subject invention, and withdrawal of this ground for rejection is respectfully requested.

Thus, for at least these reasons, Appellants respectfully submit that claim 1-23 are patentable.

Ground 2 -- Rejection Of Claims 1-27

Claims 1-27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. Appellants respectfully submit that the Examiner's rejection is improper and should be reversed.

Rejection has been raised with regard to independent claims 1 and 14 and what is meant by "activation." Reference is made to the above-discussed locations in the specification with regard to the rejection under 112 first paragraph.

Additional rejection is made to the words "adapted to." In this regard, attention is directed to the independent claims, in particular their sub-parts labeled as (i) and (ii). This language makes it clear that it is the interaction of the extensible liquid impermeable outer cover material and the non-tensioned elastic and the relationship of these materials that upon activation they will, as a composite, have a retraction capability differential of at least 10% and they will attain a three-dimensional configuration. Various exemplary ways to practice the invention, but not limiting it, are seen at page 5, line 17 to page 7, line 22, as well as in the supporting drawings and the remainder of the specification. Further attention is also directed to page 3, line 37 to page 4, line 6 for additional understanding of this limitation.

Additional rejection is made to the limitation that the elastic is "non-tensioned." This term is defined throughout the application, for example, at page 6, lines 7-29, specifically, lines 9-10. Attention is also directed to page 4, lines 6-8, where it states, "the non-tensioned elastic (34) is connected or otherwise associated with the outer cover material (32) prior to extending the outer cover material (32)." In these locations, for example, it generally refers to the elastic state before "activation" at which time it is non-tensioned or in a relaxed state.

Further rejection is made to claims 1 and 14 with regard to what the claimed extensibility is in reaction to, i.e., what force is applied to extend the liner composite at least 25%. In this regard, attention is directed to page 3, line 34 to page 4, line 37 and specifically page 4, lines 10-12 where it states, "for example the outer cover material (32) – or portions thereof – is desirably capable of extending no less than...25%... ." This discussion, as well as that throughout the specification and noted above with regard to "activation," indicates to what the extensibility of the outer cover material relates.

Further rejection is made to claims 1, 14, 24, and 26 with regard to what is meant by an "extensible, liquid impermeable outer cover material." Extensibility is defined and described in the present application, particularly at page 3, line 34 to page 9, line 4.

Further rejection is made to claims 2 and 17 with regard to the limitation "the three-dimensional configuration is a spacer element." While it was believed to be clear, additional clarity was previously added by striking the word "is" and adding the word "comprises" to alleviate any ambiguity. For further understanding, attention is also directed to page 13, lines 3-13 as well as page 12, lines 30-35.

Further rejection is made to claim 3 and the language "associated with and superposed on...to thereby form a periphery." In this regard, attention is directed to page 4, lines 1-8 which defines "associated" and to page 12, lines 9-18 and figures 15-16, for example, which discuss the "superposed" relationship of the elements.

Ground 3 – Rejection Of Claims 2-13 and 17-23

Claims 2-13 and 17-23 stand rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential elements. Appellants respectfully submit that the Examiner's rejection is improper and should be reversed.

This rejection is not believed proper in light of the overall discussion of the invention throughout the specification, and particularly at, for example, page 3, line 34 to page 4, line 8 which discusses the essential elements of the invention in a complete way. As concerns the spacer element and its "structure" in the absorbent article, attention is directed to page 6, lines 7-29 which discusses the non-tensioned elastic and outer cover material and in particular the relationship between these two and their interaction, and page 7, line 28 to page 8, line 6, as additional discussion of some exemplary ways of practicing the invention. Still further, within the claims themselves, namely in the independent claims that are then referenced by the dependent claims being rejected, the independent claims state that the non-tensioned elastic (34) is associated with at least a portion of a surface (36, 38) of the outer cover material (32), and that upon activation it is the interaction or "associated" nature of these two elements that are adapted to having a retraction capability differential and that attain a three-dimensional configuration. In alternative scopes of the invention set forth in the dependent claims, such three-dimensional configuration comprises the spacer element (74).

Finally, it is well accepted that the interpretation of patent claims is not done separate and independent from the specification and balance of the application on file. As such, while it is desirable to not have to refer to the specification to understand what a claim word means, such is not practical nor is it consistent with the accepted law and practice for interpreting a claim's meaning and scope. Differently, the claim language must be read and interpreted in conjunction with the meaning and understanding provided by the accompanying specification and drawings, and such is the case for the present application

Ground 4 – Rejection Of Claims 1-27

Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as being obvious and therefore unpatentable over Coles alone or in view of Osborn. Appellants respectfully submit that the Examiner's rejection is improper and should be reversed. In particular, Coles and Osborn, alone or in combination, fail to teach or suggest all of the claim limitations.

In making an obviousness determination it is well-known that one must consider the claimed invention as a whole. In this regard, the discussion of the Appellants' invention disclosed in the specification and drawings, from above, is reasserted here by reference. In particular, the independent claims each recite a composite outer cover, the composite outer cover including an extensible, liquid impermeable outer cover material and a non-tensioned elastic. The non-tensioned elastic and the extensible, liquid impermeable outer cover material are associated with each other, where, upon activation of the composite outer cover at least a portion of the composite outer cover where the outer cover material and the non-tensioned elastic are associated is adapted to: (i) have a retraction capability differential of at least 10% and (ii) attain a three-dimensional configuration. It is the unique combination of the extensible, liquid impermeable outer cover material and the non-tensioned elastic, and their association with each other before, and then upon, activation of the composite outer cover, that defines the invention not taught or suggested in the documents of record. It is discovery of these materials, their combination and then their association and interaction when the absorbent article is being donned by the wearer, or during use by the wearer, that defines the invention that has not been taught or suggested before. For example, attention is directed to the specification at page 7, line 23 to page 8, line 6, in addition to the remainder of the specification drawings which support the claimed invention.

It is further recognized that when making an obviousness determination the reference(s) must be considered as a whole and suggest the desirability, and thus the obviousness, of modifying or combining the referenced teaching(s) to obtain Appellants' claimed invention. In MPEP Section 2143, the three basic elements of a valid *prima facie* case of obviousness in view of a reference are presented as:

1. some suggestion or motivation to **modify the reference** or to combine reference teachings;

2. a **reasonable expectation of success** in the modification or combination; and

3. a teaching or suggestion of **all** the claim elements in the reference(s) (emphasis added).

The Office Action has not provided Appellants with a reference, or combination of references, that teach or suggest **all** the elements of Appellants' claimed invention. Of particular note, the cited Coles reference fails to teach or suggest an extensible, liquid impermeable outer cover material, such outer cover material being a clearly recited element of the subject invention and necessary to practice the inventive composite outer cover. The Office Action recognizes that this element is missing from the Coles reference in two regards. First, the Office Action recognizes that Coles does not disclose a retraction capability differential. Second, the Office Action recognizes that Coles only discloses a layer that is generally inextensible and only extends, if at all, at most 5% across the wide range of force between 0.5 and 5 N/cm. To compensate for these deficiencies, the Office Action proposes that even if Coles does not teach such an extensible layer, the reference of Osborn does teach the use of an extensible layer in combination with the stretchable elastic film, scrim, or other elastic element 1 taught in Coles.

These arguments are deficient and not proper when conducting an obviousness analysis, for several reasons. First, the subject invention clearly defines extensible to mean capable of extending no less than 10% and links that percentage of extension to the formula noted on page 5 at lines 10-14 and coupled to the test method noted at page 14. That Coles taught "elongation of not more than 5%" (Coles at column 8, lines 10-11) is far different than the extensible requirement of "capable of extending no less than 10%" (subject application at page

4, line 11) for the extensible, liquid impermeable outer cover material of the present invention. Further, looking to the purpose and function of the unextensible or unelongatable layer 3 taught in Coles, such layer 3 could not be readily substituted with an extensible layer as taught in Osborn. The teaching throughout Coles and at, for example, column 3, lines 29-38 and column 4, lines 14-26, clearly teaches that Coles requires a stretchable elastic layer in combination with a unelongatable layer to achieve the function and objectives Coles taught and claimed.

Critical to Coles is that during activation the elastic composite member can be extended beyond its unactivated length and such imparts a physical deformation pattern to the composite member, mainly, the unelongatable layer is permanently elongated or ruptured such that upon retraction of the elastic member a number of pleats or perforations are formed at the outer surface of the composite. This is taught further at column 9, lines 38-48 as causing gathers to be formed between bond areas of the two layers, the elastic layer and the unextensible layer. At column 8, line 56 to column 9, line 14, it further supports this requirement, and in particular states, "Activation of the composite elastic member 1 can occur by imparting a physical deformation to the inelastic layer 3, which renders the layer 3 permanently elongatable."

Throughout the specification, as embodied in the examples discussed here, and particularly recited as the definition of the first layer 3, Coles states, "With relatively unextensible or unelongatable it is meant that the layer 3 has an elongation of not more than 5% at a force between 0.5 N/cm and 5 N/cm, preferably between 1.5 N/cm and 3 N/cm" (emphasis added). It would be clearly contrary to Coles to simply substitute an extensible layer, as may be taught in Osborn, for the unextensible layer 3 required by Coles. Further, even assuming such a substitution could be properly made, which the Appellants assert cannot under the doctrine of obviousness, it is unlikely that the composite structure would function as required by Coles, namely, resulting in a retracted composite having gathers on the exterior surface formed by the exterior extensible member that has been substituted for the Coles' required unextensible layer. Much differently, if the layer 3 of Coles, which is taught to be unextensible, were to be substituted from Osborn and be extensible, the composite material may very likely not form the necessary gathers that are taught in Coles. With such extensibility, Coles' modified composite would very likely not be able to achieve the required permanent elongation resulting from deformation or rupturing of that layer which is adjacent Coles stretchable elastic member 3. As such, it would not be obvious to substitute any extensible material layer from Osborn into Coles because of the loss of intended invention taught by Coles. Rather, this appears to be a case where hindsight reconstruction, using the Appellants' invention as a template, is going on to support the requirement of a reasonable expectation of success for the proposed combination of features from Coles and Osborn. It is readily accepted that such hindsight reconstruction is not acceptable in an obviousness analysis.

In summary, Coles alone and in combination with Osborn fails to teach all the claimed elements of the subject invention, namely, at least the extensible liquid impermeable outer cover material. This single difference, while it may appear as only one claim element on its face, is quite significant because this element is a part of the composite outer cover, and in the combination with the non-tensioned elastic, these two elements provide many features that neither of them alone can provide to the invention of the Appellants (i.e., this is definitely a case where the sum of the parts is worth more than each part alone). Without the extensible liquid impermeable outer cover material feature, the unique combination of features of the invention cannot be obvious in light of the documents cited. Coles is lacking this feature, and the resulting combination, and there is not a proper suggestion or motivation to include this feature because of Coles' express teachings against such. Moreover, even if such could be properly included, the resulting structure is not Appellants' invention. For all these reasons, it is believed that a valid *prima facie* case of obviousness has not been made. Accordingly, the rejection of the claims based on 35 U.S.C. § 103 (a) is respectfully requested to be withdrawn.

For at least the reasons set forth above, Appellants respectfully request that all the rejections under 35 U.S.C. § 103 be withdrawn.

Conclusion

For the reasons stated above it is Appellants' position that the Examiner's rejection of claims has been shown to be untenable and should be **reversed** by the Board.

Any additional prosecution fees which are due may be charged to deposit account number 11-0875.

The undersigned may be reached at: (920) 721-8863

Respectfully submitted,
GEORGIA L. ZEHNER ET AL.

By:
Randall W. Fieldhack
Registration No.: 43,611

Claims Appendix

1. A disposable absorbent article having a longitudinal centerline (70) and a lateral centerline (72), the article comprising:

   a fluid permeable liner (48);

   a composite outer cover (30), the composite outer cover (30) including: (a) an extensible, liquid impermeable outer cover material (32) having an upper surface (36) and an opposing lower surface (38); and (b) a non-tensioned elastic (34), the non-tensioned elastic (34) being associated with at least a portion of a surface (36, 38) of the outer cover material (32), wherein upon activation of the composite outer cover at least a portion of the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are associated, is adapted to (i) have a retraction capability differential of at least 10 % and (ii) attain a three-dimensional configuration, and wherein at least that portion of the outer cover material (32) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are associated, is adapted to extend no less than 25 %; and

   an absorbent core (50) disposed intermediate the liner (48) and the composite outer cover (30).

2. The disposable absorbent article of claim 1, wherein the three-dimensional configuration comprises a spacer element (74) formed in the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are associated.

3. The disposable absorbent article of claim 2, wherein the composite outer cover (30) is associated with and superposed on the liner (48) to thereby form a periphery (52), the periphery (52) generally including longitudinal side edges (54) and lateral end edges (56).

4. The disposable absorbent article of claim 3, wherein at least a portion of the spacer element (74) is disposed inboard from a longitudinal side edge (54) toward the longitudinal centerline (70).

5. The disposable absorbent article of claim 1, wherein the non-tensioned elastic (34) is associated with the upper surface (36) of the outer cover material (32).

6. The disposable absorbent article of claim 3, wherein at least a portion of the spacer element (74) is disposed inboard from a lateral end edge (56) toward the lateral centerline (72).

7. The disposable absorbent article of claim 6, wherein the non-tensioned elastic (34) is associated with the upper surface (36) of the outer cover material (32).

8. The disposable absorbent article of claim 3, wherein at least a portion of the spacer element (74) is disposed outboard from the longitudinal centerline (70).

9. The disposable absorbent article of claim 8, wherein at least a portion of the spacer element (74) resides on the longitudinal centerline (70).

10. The disposable absorbent article of claim 9, wherein the non-tensioned elastic (34) is associated with the upper surface (36) of the outer cover material (32).

11. The disposable absorbent article of claim 3, wherein at least a portion of the spacer element (74) is disposed outboard from the lateral centerline (72).

12. The disposable absorbent article of claim 11, wherein at least a portion of the spacer element (74) resides on the lateral centerline (72).

13. The disposable absorbent article of claim 12, wherein the non-tensioned elastic (34) is associated with the upper surface (36) of the outer cover material (32).

14. A composite outer cover (30) suitable for incorporation into a disposable absorbent article, the composite outer cover (30) comprising: (a) an extensible, liquid impermeable outer cover material (32) having an upper surface (36) and an opposing lower surface (38); and (b) a non-tensioned elastic (34), the non-tensioned elastic (34) being associated with at least a portion of a surface (36, 38) of the outer cover material (32), and wherein upon activation of the composite outer cover at least that portion of the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are associated, is adapted to: (i) have a retraction capability differential of at least 10 % and (ii) attain a three-dimensional configuration.

15. The composite outer cover (30) of claim 14, wherein the three-dimensional configuration has a distal edge (80) and a base region (78), the distal edge (80) and the base region (78) being in spaced relation from each other.

16. The composite outer cover (30) of the claim 15, further comprising a longitudinal centerline (70) and a lateral centerline (72).

17. The composite outer cover (30) of claim 16, wherein the three dimensional configuration comprises a spacer element (74) formed in the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are associated.

18. The composite outer cover (30) of claim 17, wherein at least a portion of the spacer element (74) is disposed outboard from the longitudinal centerline (70).

19. The composite outer cover (30) of claim 18, wherein at least a portion of the spacer element (74) resides on the longitudinal centerline (70).

20. The composite outer cover (30) of claim 19, wherein the non-tensioned elastic (34) is associated with the upper surface (36) of the outer cover material (32).

21. The composite outer cover (30) of claim 17, wherein at least a portion of the spacer element (74) is disposed outboard from the lateral centerline (72).

22. The composite outer cover (30) of claim 21, wherein at least a portion of the spacer element (74) resides on the lateral centerline (72).

23. The composite outer cover (30) of claim 22, wherein the non-tensioned elastic (34) is associated with the upper surface (36) of the outer cover material (32).

24. A disposable absorbent article having a longitudinal centerline (70) and a lateral centerline (72), the article comprising:

a fluid permeable liner (48);

a composite outer cover (30) joined to the fluid permeable liner (48), the composite outer cover (30) including:

an extensible, liquid impermeable outer cover material (32) having an upper surface (36) and an opposing lower surface (38), and

a non-tensioned elastic (34), the non-tensioned elastic (34) joined to the outer cover material (32), wherein at least a portion of the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are joined, when extended no less than 25% with a tensile force of 30 gmf per inch, has a retraction capability differential of at least 10 % and attains a three-dimensional configuration; and

an absorbent core (50) disposed intermediate the liner (48) and the composite outer cover (30).

25. The disposable absorbent article of claim 24, wherein the three-dimensional configuration comprises a spacer element (74) formed in the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are joined.

26. A disposable absorbent article having a longitudinal centerline (70) and a lateral centerline (72), the article comprising:

a fluid permeable liner (48);

a composite outer cover (30) joined to the fluid permeable liner (48), the composite outer cover (30) including

an extensible, liquid impermeable outer cover material (32) having an upper surface (36) and an opposing lower surface (38), and

a non-tensioned elastic (34), the non-tensioned elastic (34) being joined with at least a portion of a surface (36, 38) of the outer cover material (32), wherein, upon elongation and retraction of the composite outer cover during normal use of the disposable absorbent article, at least a portion of the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are joined is adapted to

(i) have a retraction capability differential of at least 10 %, and

(ii) attain a three-dimensional configuration, and wherein at least that portion of the outer cover material (32) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are joined is adapted to extend no less than 25 % at a tensile force of 30 gmf per inch; and

an absorbent core (50) disposed intermediate the liner (48) and the composite outer cover (30).

27. The disposable absorbent article of claim 26, wherein the three-dimensional configuration comprises a spacer element (74) formed in the composite outer cover (30) adjacent where the outer cover material (32) and the non-tensioned elastic (34) are joined.

Evidence Appendix

None.

Related Proceedings Appendix

See the attached decision on appeal rendered in related case U.S. Patent Application Serial No. 10/680,968 on August 21, 2007.

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The opinion in support of the decision being entered today is *not* binding precedent of the Board.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GEORGIA L. ZEHNER
and DUANE G. UITENBROEK

Appeal 2007-1560
Application 10/680,968
Technology Center 1700

Decided: August 21, 2007

Before CHUNG K. PAK, CATHERINE Q. TIMM, and JEFFREY T. SMITH, *Administrative Patent Judges.*

SMITH, *Administrative Patent Judge.*

DECISION ON APPEAL

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1-31. We have jurisdiction under 35 U.S.C. § 6.

Appellants' invention relates to liner composites suitable for incorporation into disposable absorbent articles. An understanding of Appellants' claimed invention can be gleaned from independent claim 1 which appears below:

> 1. A disposable absorbent article having a longitudinal centerline (70) and a lateral centerline (72), the article comprising:
>
> a liquid impermeable outer cover (48);
>
> a liner composite (30), the liner composite (30) including: (a) an extensible, fluid permeable liner material (32) having an upper surface (36) and an opposing lower surface (38); and (b) a non-tensioned elastic (34), the non-tensioned elastic (34) being associated with at least a portion of a surface (36, 38) of the liner material (32), wherein upon activation at least a portion of the liner composite (30) adjacent where the liner material (32) and the non-tensioned elastic (34) are associated is adapted to (i) have a retraction capability differential of at least 10% and (ii) attain a three-dimensional configuration, and wherein at least that portion of the liner material (32) adjacent where the liner material (32) and the non-tensioned elastic (34) are associated is adapted to extend no less than 25%; and
>
> an absorbent core (50) disposed intermediate the outer cover (48) and the liner composite (30).

The Examiner relies on the following references in rejecting the appealed subject matter:

Coles	EP 0 650 714 A1	May 3, 1995
Osborn, III	US 6,287,288 B1	Sep. 11, 2001

I. Claims 1-31 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in such a way as to enable one skilled in the art to make and/or use the invention.

The issue presented is: Whether the Examiner has established that the subject matter of claims number 1-31 meets the enablement requirements of 35 U.S.C. § 112, first paragraph? We answer this question in the negative.

The Examiner contends that the Specification does not have an enabling disclosure for the subject matter of claims number 1-31. Specifically, the Examiner states, (Answer 3), "[t]he specification as originally filed, with one skilled in the art to make the claimed invention because it does not disclose what is meant by activation, or how activation is achieved."

The first paragraph of 35 U.S.C. § 112 requires nothing more than an objective enablement. *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). How such teaching is set forth, either by use of illustrative examples or by broad terminology, is irrelevant. *Id.* As those skilled in the art will appreciate, the Specification, pages 5-10, provides lists of suitable materials for forming the disposable absorbent articles that comprise a liner composite material. The specification discloses the action of stretching the article and retracting to original dimensions activates the liner (Specification, 8). Since Appellants' Specification contains a written description of the suitable backing materials and the action required for activation of the liner material corresponding with the scope of the claims on appeal, compliance with the enablement requirement is presumed. *Marzocchi*, 439 F.2d at 223-24, 169 USPQ at 369-70.

It is the Examiner's burden to present adequate basis for doubting the objective truth of Appellants' statements in the Specification, i.e., to provide scientific reasoning and/or evidence as to why one of ordinary skill in the art would not have been able to make and use the full scope of the subject matter claimed based on the written description of the invention in the Specification without undue experimentation. *Id.* On this record, however, the Examiner has not carried this burden. The Examiner has not proffered any adequate scientific reasoning and/or evidence to doubt the accuracy of Appellants' statements in the Specification. (*See* Answer 3-6).

The Appellants point to specific portions of the Specification to address the concerns raised by the Examiner (Br. 4). Appellants specifically disclose that the combination of stretching and retracting portions of the composite material, achieved when donning the article, activates the composite (Br. 4).

The Examiner has failed to explain why the portions of the Specification identified by the Appellants would not have been suitable for a person of ordinary skill in the art to practice the full scope of the claimed subject matter.

Accordingly, we are constrained to reverse the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 1-31 as lacking an enabling disclosure for the subject matter presently claimed.

II. Claims number 1-31 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

The issue presented is: Has the Examiner established that the subject matter of claims number 1-31 meets the requirements of 35 U.S.C. § 112, second paragraph? We answer this question in the negative.

The Examiner contends that several terms and phrases such as "activated" and "adapted to" of claims number 1-31 are not clear and therefore render the claims are indefinite (Answer 6-8).

"The legal standard for definiteness [under the second paragraph of 35 U.S.C. § 112] is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The inquiry is to determine whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. The definiteness of the language employed in a claim must be analyzed not in a vacuum, but in light of the teachings of the particular application. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

After consideration of the present record, we determine that a person of ordinary skill in the art would have recognized the disputed claim language covers disposable absorbent articles that comprise a liner composite material. The claimed invention and the Specification include references to specific elements of the drawings that correspond to various aspects of the claimed invention. The Specification includes lists of representative materials suitable for use in the disposable absorbent articles (*see* Specification generally). There is nothing inherently wrong with defining some part of an invention in functional terms or based upon specified properties. The identification of properties and functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971). Thus, we determine that the claims reasonably apprise those of ordinary skill in the art of their scope. Accordingly, we reverse the Examiner's § 112, second paragraph, rejection of claims number 1-31 as indefinite.

III. Claims number 1-31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Coles alone or in view of Osborn.[1]

The Examiner contends that Coles discloses an absorbent article which comprises a topsheet, a back sheet, and an absorbent core. The topsheet is permeable. The absorbent article has an elastic composite which can be attached to either the topsheet or the backsheet. Coles teaches forming an elastic composite which can be applied to various regions of the absorbent article where elasticity is desired. The elastic composite is formed by attaching the elastic in a relaxed state, (which is equated to the claimed non-tensioned state) to another layer such as a nonwoven fabric. The elastic composite is activated by stretching (Answer 8). The Examiner recognizes that Coles does not disclose the retraction capability. The Examiner contends that Osborn teaches absorbent articles comprising extendable materials for the topsheet and/or the backsheet of the article. The Examiner concluded that it would have been obvious to one of ordinary skill in the art to have employed an extensible top-sheet or backsheet in the absorbent article of Coles, motivated by the expectation that this would enhance the comfort of the wearer of the absorbent article (Answer 9).

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[1] For this ground of rejection, Appellants have grouped their arguments together. We select claim 1 as representative of the rejected claims and will limit our discussion thereto.

Appellants contend that the Examiner has not provided a reference or combination of references that teach or suggest all of the claimed elements (Br. 9). Appellants contend that Coles alone and in combination with Osborn fails to teach the claimed elements of the subject invention, namely, at least the extensible fluid permeable liner material. Specifically, Appellants state:

> Coles and Osborn, alone or in combination, fail to teach or suggest all of the claim limitations.... Of particular note, the cited Coles reference fails to teach or suggest an extensible, fluid permeable liner material, such liner material being a clearly recited element of the subject invention and necessary to practice the inventive liner composite. The Office Action recognizes that this element is missing from the Coles reference in two regards. First, the Office Action recognizes that Coles does not disclose a retraction capability differential. Second, the Office Action recognizes that Coles only discloses a layer that is generally inextensible and only extends, if at all, at most 5% across the wide range of force

> between 0.5 and 5 N/cm. To compensate for these deficiencies, the Office Action proposes that even if Coles does not teach such an extensible layer, the reference of Osborn does teach the use of an extensible layer in combination with the stretchable elastic film, scrim, or other elastic element 1 taught in Coles. (Br. 9-10).

Appellants contend that Coles clearly teaches that the invention requires a stretchable elastic layer in combination with an unelongatable layer to achieve the function and objects of the Coles taught and claimed invention. Appellants further contend it would have been "clearly contrary to the Coles reference to simply substitute an extensible layer, as may be taught in Osborn, for the unextensible layer 3 required by Coles. Further, even assuming such a substitution could be properly made, which the applicants' assert cannot under the doctrine of obviousness, it is unlikely that the composite structure would function as required by Coles, namely, resulting in a retracted composite having gathers on the exterior surface" (Br. 11).

The issue presented is as follows:

Has with the Examiner reasonably determined that Coles, alone or in combination with Osborn, would have led a person of ordinary skill in the art to form an absorbent article comprising a liner composite including an extendable fluid permeable liner material and a non-tensioned elastic having a portion of the liner composite that has a three-dimensional configuration and comprises a retraction capability deferential of it least 10 %, within the meaning of 35 U.S.C. § 103? On this record, we answer this question in the affirmative.

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). "[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007) *quoting In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-337 (Fed. Cir. 2006); *see also DyStar Textilfarben GmBH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006)("The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself."); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)("Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"); *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969) ("[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom . . ."). The analysis supporting obviousness, however, should be made explicit and should "identify a reason that would have prompted a person of ordinary skill in the art to combine the elements" in the manner claimed. *KSR*, 127 S. Ct. at 1731, 82 USPQ2d at 1389.

The Examiner has found that Coles describes an absorbent article that comprises all of the elements of the present invention. The Examiner recognized that Coles did not expressly describe the retraction capability differential of at least 10% as specified in the claimed invention (Answer 8-9). However, the Examiner properly asserted that it would have been obvious to a person of ordinary skill in the art to have employed an extendable topsheet or backsheet in the absorbent article of Coles (Answer 9). The Examiner cited the Osborn reference for describing extendable materials suitable for formation of the topsheet and/or backsheet of an absorbent article (Answer 9). Coles discloses the object of the invention is to provide an absorbent article by which stretchability can easily be provided in selected areas and in a selected direction and in which the degree of extendability can easily be controlled (col. 2, l. 54-col. 3, l. 1). A person of ordinary skill in the art would have understood the proper conditions for adding elastically extendable layers to composite materials (*see* Coles and Osborn generally). While Coles may have a preference for a certain degree of stretching in which the composite layer could have been extended, this does not detract from the knowledge of persons of ordinary skill in this art who may desire an article that has further stretching capability. The Osborn reference is evidence that the selection of liner materials that provide a retraction capability differential specified by the claimed invention would have been well within the capabilities of a person of skill in this art. Contrary to Appellants' arguments, the use of materials having an elongation of at least 10% in the invention of Coles would not have destroyed Cole's intended purpose of producing an absorbent article that could easily be stretched in selected areas.

For the foregoing reasons and those presented in the Answer, the rejection of claims number 1-31 under 35 U.S.C. § 103(a) as obvious over the combined teachings of Coles and Osborn is affirmed. As a final point with respect to the § 103 rejections, we note that Appellants base no argument upon objective evidence of nonobviousness, such as unexpected results.

ORDER

The rejection of claims number 1-31 under 35 U.S.C. § 112, first and second paragraphs are reversed. The rejection of claims 1-31 under 35 U.S.C. §103 (a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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